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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,710	05/25/2006	Ichinori Takada	112857-559	5132

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EXAMINER	
GARRETT, DAWN L	
ART UNIT	PAPER NUMBER
1794	
MAIL DATE	DELIVERY MODE
05/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,710	TAKADA ET AL.	
	Examiner	Art Unit	
	Dawn Garrett	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18,19,21-23,25,27,29,30 and 32-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18,19,21-23,25,27,29,30 and 32-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 May 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2009 has been entered.

2. The amendment filed May 6, 2009 has been entered. Claims 1-17, 20, 24, 26, 28, and 31 are cancelled. Claims 18, 23, 25, 27, and 29 were amended. Claims 32-39 have been newly added.

3. The rejection of claims 18 and 19 under 35 U.S.C. 102(b) as being anticipated by Hosokawa et al. (JP 2002-69044) is withdrawn.

4. The rejection of claims 23 and 25-31 under 35 U.S.C. 103(a) as being unpatentable over Hosokawa et al. (JP 2002-69044) is withdrawn.

5. The rejection of claims 18-31 under 35 U.S.C. 103(a) as being unpatentable over Oh et al. (US 2003/0118866 A1) is withdrawn.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

> patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by VanSlyke et al. (US 5,061,569). VanSlyke et al. discloses compound 4,4'-bis[N-(8-fluoranthenyl)-N-phenylamino]biphenyl, which anticipates the claims (see column 7, lines 50-55). It is noted that as presently shown instant General formula (2) does not limit at which position the fluoranthene groups are bonded to the nitrogens.

8. Claims 1, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Gui et al. (US 2006/0021647 A1). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

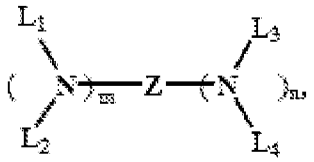
Gui et al. discloses compound 4,4'-bis[N-(8-fluorantheyl)-N-phenylamino]biphenyl, which anticipates the claims (see Gui et al. claim 14, page 11). It is noted that as presently shown instant General formula (2) does not limit at which position the fluoranthene groups are bonded to the nitrogens.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 18, 19, 21-23, 25, 27, 29, 30 and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh et al. (US 2003/0118866 A1) in view of Hosokawa et al. (JP 2002-69044). Oh et al. discloses the following general formula of compounds for an organic electroluminescent device:



In the above formula, L1-L4 may be substituted or unsubstituted aromatic groups (see par. 35). Z may be A1 wherein A1 includes aromatic hydrocarbon groups, which includes biphenyl, bianthracenyl and binaphthyl (see par. 31 and 32, par 71-72 and biphenyl and binaphthyl groups in Oh et al. claim 16, page 20). Oh et al. does not *exemplify* fluoranthene groups as the aromatic groups for two of L1-L4, but does generally teach aromatic groups having the required number of carbon atoms and similar groups to fluoranthene. Hosokawa et al. teaches in analogous art fluoranthene groups as substitution groups for diamine compounds (see compound A24, page 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected biphenyl, binaphthyl or bianthracenyl for Z and fluoranthene groups for two of L1-L4 groups of the Oh et al. compound, because one would expect the compound to result in a predictable material for a device, since such a compound is within the definition set forth by Oh et al. and fluoranthene groups are taught as known substitution groups for a diamine according to Hosokawa et al.

With regard to the method claims, Oh et al. teaches method steps using halogenated reactants and reactants with a nitrogen-containing group along with metal catalysts (see pages 16-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the compounds of Oh et al. using the same methods as set forth in claims 23, 25, 27, 29 and 30, because Oh et al. generally discloses final products according to instant formula (3) and reactant steps according to the instant formulas in order to form the final product. One would expect the methods taught by Oh et al. to result in compounds suitable for the Oh et al. device. Furthermore, the modification of the process would have been within the capabilities of one skilled in the art. "Selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results" In re Burhans, 69 USPQ 330.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 18, 19, 21, 22, and 32-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 9-12 of copending Application No. 10/595,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because although '563 claims a light emitting element comprising compounds, the present claims set forth compounds for an element within the limitations for a compound set forth in '563.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

With regard to Oh et al., applicant argues Oh et al. does not disclose a green light emitting material. The examiner submits Oh et al. teaches compounds within the formula set forth by applicant. The same compounds would be expected to have the same light emitting properties. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430. Applicant further argues Oh is directed to improving red light emission of a device. The examiner submits the red light emission is provided by a red dopant not the amine compound in Oh et al. Furthermore, the

instant claims are not directed to a light emitting device. Only compound claims and methods of making a compound have been claimed by applicant.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571) 272-1523. The examiner can normally be reached Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dawn Garrett/
Primary Examiner, Art Unit 1794

May 11, 2009